

REMARKS

Claims 1-12 are all of the claims pending in the application. Claims 1-12 are rejected. Claims 1-7 are canceled. Claims 8-12 are amended. New claims 13-18 are added. No new matter is presented. Support for the amendment is found, for example in the original claims, page 23, 4th full paragraph and last full paragraph and Example 1.

I. Response to Rejection under 35 U.S.C. § 112, second paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite.

The Examiner indicates that the recitation of "having a repeating unit represented by Formula (1) below" is confusing and seemingly inappropriate because in the Examiner's view Formula (1) does not represent a repeating unit but a complete polymer structure.

While Applicants consider that one skilled in the art would have understood what was being claimed, in order to expedite allowance Applicants have deleted the recitation at issue.

The Examiner also indicates the term "using" in claim 8 is insufficient to clearly indicate the process necessary to make the claimed film.

Claim 8 has been amended to recite "thermally treating" instead of "using," thereby obviating the rejection.

Accordingly, Applicants respectfully request withdrawal of the §112, second paragraph rejection.

II. Response to Rejections Under 35 U.S.C. §102 Over Yamasaki et al (U.S. Patent No. 7,001,673) and JP 2002-293824

Claims 1-12 are rejected under 35 U.S.C. §102 as allegedly being anticipated by each of Yamasaki et al. (U.S. Patent No. 7,001,673) and JP 2002-293824 (as interpreted by the English language equivalent, Yamasaki et al).

Applicants respectfully traverse these rejections.

In view of the foregoing amendments, the present invention is directed to a porous insulating film and processes for making the same. Each of Yamasaki et al. (U.S. Patent No. 7,001,673) and JP 2002-293824 merely disclose a polymer or film-forming composition and fail to disclose a porous insulating film as recited in claim 8 or a process for manufacturing the same as recited in newly added claim 15. Due to at least this deficiency, each of Yamasaki et al and JP 2002-293824 fails to teach or suggest all of the elements of the present claims and therefore do not anticipate the present invention.

Accordingly, Applicants request withdrawal of these §102 rejections.

III. Response to Obviousness-Type Double Patenting Rejection Over Yamasaki et al

Claims 1, 2, 6, 8 and 9 are rejected on the ground of non-statutory obviousness-type double patenting as allegedly being unpatentable over claims 1 and 2 of U.S. Patent No. 7,001,673. It is the Examiner's position that although the conflicting claims are not identical, they are not patentably distinct from each other because the polymer in claim 1 of '673 allegedly falls within the breadth of instant claim 1.

Applicants respectfully submit that the hydrophilic layer of '673 is not porous and therefore differs from the porous insulating film of the invention as presently claimed. Further there is no motivation for one of ordinary skill in the art to modify the hydrophilic layer recited in the claims of the '673 patent with a reasonable expectation of success in achieving the present invention. Thus, Applicants respectfully request withdrawal of the double-patenting rejection.

IV. Claim Rejection Under 35 U.S.C. § 102 Over Brown

Claims 1, 2, 6, 8 and 9 are rejected under 35 U.S.C. §102(e) as allegedly being anticipated by Brown (U.S. Patent No. 6,733,884).

Applicants respectfully traverse the rejection.

Brown fails to teach or suggest all of the elements of the presently claimed invention. Specifically, Brown does not teach or suggest an insulating film that is porous. For at least this reason, Brown does not anticipate the present invention.

Applicants thus respectfully request withdrawal of the §102 rejection over Brown.

V. Claim Rejection Under 35 U.S.C. §103(a) over Brown in view of Berger et al.

Claims 3 to 5, 7 and 10 to 12 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Brown in view of Berger et al.

As noted above, Brown fails to teach an insulation film that is porous. Further the Examiner recognizes that Brown also fails to teach the presence of a silane that meets formula (2) or (3) in the polymer composition therein as recited in canceled claim 3. Applicants note the recitation of said silane in claims 10-12.

To remedy this deficiency, the Examiner relies on Berger et al., referred to by Brown et al. Applicants note, however, that Brown teaches away from the coupling agents disclosed by

Berger et al. One skilled in the art would understand the coupling agents of Berger to be undesirable since Brown states that the coupling agents of Berger et al do not have the desired covalent bonding property. Brown teaches that Berger et al discloses the treatment of titanium dioxide particles with a polyether substituted silicon compound as the coupling agent, but that the polyether substituted silicon compounds are not disclosed to form covalent bonds with the plastic or resin system. See column 1, lines 43-53. Further, Brown teaches that coupling agents are desired that can provide covalent bonds between the interface of the inorganic material and an organic material. Column 1, lines 55-57. Accordingly, one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner.

Applicants therefore request withdrawal of the rejection under §103.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. § 1.111
U.S. App. Ser. No. 10/807,391

Q80448

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: July 7, 2006


Jennifer M. Hayes
Registration No. 40, 641